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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,721	09/29/2003	Yuji Imaizumi	045070-5036	9270
9629	7590	05/22/2006		
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
			EXAMINER BEISNER, WILLIAM H	
			ART UNIT	PAPER NUMBER
			1744	

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/671,721	<b>Applicant(s)</b> IMAIZUMI ET AL.	
	<b>Examiner</b> William H. Beisner	<b>Art Unit</b> 1744	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 25-31,33,34,36,38 and 39.
- Claim(s) withdrawn from consideration: 1-15 and 21-23.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13. ☒ Other: See Continuation Sheet.

  
 William H. Beisner  
 Primary Examiner  
 Art Unit: 1744

Continuation of 13. Other: In view of the amendment filed 5/9/2006, claims 25-21, 33-34, 36, 38 and 39 stand rejected under 35 U.S.C. 102(e) as being anticipated by Yao et al.(US 2003/0100059). With respect to the rejection of the instant claims over the reference of Yao et al., Applicants argue that the rejection of the claims is improper because the reference of Yao et al. does not teach or suggest the claimed "specifying means" to specify the noted region in the specimen and "selection means" to select the intensity of the second light emitted from that noted region. Applicants stress that the reference of Yao et al. does not teach a "specifying means" that specifies a noted region as having cells that include the protein and the cells that do not have the protein and stress that the reference of Yao et al. does not teach a "selection means" that detects the second light emitting from the cells having the protein and cells having no protein. In response, Applicants' comments are not found to be persuasive because the Examiner is of the position that the device disclosed by the reference of Yao et al. is structurally the same as that of the instant claims. They both include optical excitation and detection systems for exciting and detecting the same wavelengths of light and employ image capture and processing devices. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant application, the reference of Yao et al. is structurally capable of performing the intended use recited in the instant claims. Applicants' comments focus on how the method performed in the instant application is different from the method performed in the Yao et al. reference yet are silent as to how the instant device "structurally" defines over the device of Yao et al. Note, if clumps of cells (See Figures 3A and 3B of the instant application) were employed in the device of Yao et al., the device of Yao et al. would be capable of identifying the noted regions based on the first light and distinguishing between noted regions with the protein and without the protein based on the detected second light over time. Furthermore, the Examiner would also like to point out that the instant claim language is not commensurate in scope with Applicants' comments. For example, independent claim 25, merely recites a "noted region" within a plurality of cells which stand adherent to another. This claim language is silent with respect to cells that do not include the stated protein. Additionally note Figure 2B of the reference of Yao et al. which depicts "noted regions" of cells including the stated protein among cells which stand adherent to one another..